

Remarks

Claims 60, 61, 63, 65, and 67 are pending in the case.

Claims 60, 61, 63, 65, and 67 stand rejected under 35 U.S.C. 112, second paragraph as allegedly failing to particularly point out and distinctly claim the subject matter regarded as the invention. The rejection cites the language "a group compatible with." This language has been removed from the claims. Claims 60, 61, 63, 65, and 67 also stand rejected under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the written description requirement.

Claim 60 has been amended to delete the former figure and substitute a revised figure. Additional amendments are also made in the claim. The claims now further define structural aspects of the molecule, and it is believed that this rejection has been overcome. Support for R₇ and R₈ and U is found at p. 19, lines 11-27. Support for "polymer" is further found at p. p. 14, lines 9-31.

With respect to the written description requirement, the Federal Circuit has indicated that the fundamental factual inquiry of the written description requirement is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572; 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997); *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016,

1021 (Fed. Cir. 1991) (one must define a compound by "whatever characteristics sufficiently distinguish it"). MPEP § 2163 I.

What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d at 1384, 231 USPQ at 94. See also *Capon v. Eshhar*, 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1085 (Fed. Cir. 2005) ("The 'written description' requirement must be applied in the context of the particular invention and the state of the knowledge.... As each field evolves, the balance also evolves between what is known and what is added by each inventive contribution."). If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be in *ipsis verbis* [i.e., "in the same words"] to be sufficient").

The rejection alleges that no written description is present because claim 60 is a broad generic claim (Office Action mailed April 30, 2008, p. 5), that its structural variations are limitless, and that there is no correlation between function and structure of "the sequence."

First, it is pointed out that claim 60 does not recite a sequence. Rather, it recites a water-soluble thioester or selenoester compound of specific formula. And the variations of the claim are not limitless. While having the breadth to cover compounds that would become obvious to the person of ordinary skill in the art having resort to the specification, the claim is confined within specific structural limitations. The person of ordinary skill in the art would readily understand, with reference to the specification, that the inventors had possession of the claimed invention as of the filing date.

The rejection alleges that no written description is present because "there is no disclosure of a correlation between function and structure of the compounds beyond compounds disclosed in the examples ..." (Office Action mailed April 30, 2008. pp. 5-6). First, it is noted that the molecule claimed is not claimed by its function. The Applicants point out there is no recitation

of function in the present claims. Rather, specific structural requirements are recited in the claim, and thus no rational underpinning for this rejection has been provided.

It is nevertheless believed that the present claims well fulfill the requirements of the written description requirement, and that the rejection is now rendered moot.


Closing

Applicants submit that the present response is complete and complies with the requirements of 35 U.S.C. §121, and that all claims are now in condition for allowance. Should the Examiner have any remaining questions regarding the subject invention or its patentability, Applicant encourages the Examiner to contact the undersigned to answer such questions or provide additional information.

Applicants believe that no fee is due in association with this response. If the Applicants are in error, the Commissioner is hereby authorized to charge any underpayment or credit any overpayment that may occur during the pendency of this application to Deposit Account No. 01-0535. Any required petitions not otherwise provided for herein are hereby constructively petitioned.

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Respectfully submitted,



Richard San Pietro
Reg. No. 45,071

AMYLIN PHARMACEUTICALS, INC.
9360 Towne Centre Drive
San Diego, CA 92121
Telephone: (858) 754-4981
Facsimile: (858) 552-1936